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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/485,298 02/08/00 YAMAMOTO J 1422-411P

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EXAMINER

CHAKRABARTI, A

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/485,298

Applicant(s)

Yamamoto et al.

Examiner

Arun Chakrabarti

Group Art Unit

1655

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☒ expires 3 months from the mailing date of the final rejection.b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Feb 26, 2001 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☐ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

☐ Applicant's response has overcome the following rejection(s):

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 17-37

☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Other

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DETAILED ACTION

1. Applicant's arguments filed on February 26, 2001, have been fully considered but they are not persuasive.

Applicant argues that Dower and Koster references cannot be combined. This argument is not persuasive, especially in the presence of a strong motivation provided by Koster, "The process of the invention provide for increased accuracy and reliability of nucleic acid detection. In addition, the process allows for rigorous controls to prevent false negative or positive results. The process of the invention provides electrophoretic steps; labeling and subsequent detection of a label. In fact it is estimated that the entire procedure, including nucleic acid isolation, amplification and mass spec analysis requires only about 2-3 hours time. Therefore, the instant disclosed processes of the invention are faster and less expensive to perform than existing DNA detection systems. In addition, because the instant disclosed processes allow the nucleic acid fragments to be identified and detected at the same time by their specific molecular weights (an unambiguous physical standard), the disclosed processes are also much more accurate and reliable than currently available procedures (Column 5, lines 26-42)".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For example, it was mentioned clearly in the last office action that Dower reference does not teach two or more kinds of

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nucleotide analogs, only Koster reference teaches the same. Similarly, uniform incorporation of analog is taught by Dower, not Koster.

In response to applicant's argument that cited references used their method for another purpose, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., nucleotide analogs are incorporated into the synthesized chain at a uniform frequency without being affected by the GC content of template) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the applicant's argument that Dower reference teaches an extra step of acid treatment, it is noted that the "comprising" language of the instant claims permits any additional steps to be included with the claimed invention.

Applicant also argues that neither references teaches amplification of nucleic acid template containing nucleic acid analogs in the presence of nucleotide analog. This argument is not persuasive. Dower reference clearly teaches amplification of nucleic acid template containing nucleic acid analogs in the presence of nucleotide analog (Column 33, lines 12-16).

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In view of the response to arguments, all rejections made in the last office action are hereby being maintained.



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Technology Center 1600

3/23/02